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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 08/804,900
Filing Date: February 24, 1997
Appellant(s): MECHALEY ET AL.

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GROUP 3600

David R. Yohannan
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/17/2006 appealing from the Office action

mailed 7/15/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Abelow	US Patent No. 5,999,908	December 7, 1999
Majmudar et al.	EPA 0 365 200 A2	March 04, 1990

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Abelow (US Patent No. 5,999,908) in view of Majmudar et al (EPA 0 365 200 A3).

As per claims 1-7 and 25, Abelow is directed to a system and method of

monitoring a product/service being used by a customer. A module is integrated within

the product/service for monitoring usage of the product and for providing reports and

market data and customer needs to a remote vendor. See column 16, lines 52-60, 9,

lines 37-46 and column 10, line 3 to column 12, line 34 of Abelow. The various

products/services described by Abelow include various components and

subcomponents. Usage data of the product and its various components and

subcomponents is collected and analyzed in order to determine future customer's

needs. Abelow further teaches providing users with additional products and services

while they are using a current product. See column 13, lines 55-58. Abelow states that

"As the Customer uses the product 16, pre-programmed trigger points are checked in

the CB-PD Module or by the Customer. If a trigger point has not been reached, the

Customer's use is not interrupted. If a trigger point is reached, the CB-PD Module

requests the Customer's participation in a Development interaction". See column 17,

line 55 to coloumn 18, line 10. Abelow further states that customers' desires are

inputted by the customers only for future development and consideration. Abelow

teaches alerting a customer or user on possible future availability of identified software

component wherein the identified component is not within the subset of software

component. Alerting the user to a [current] availability of the identified software

component, wherein the identified component is not within the subset of software

component is not explicitly stated by Abelow.

Majmudar teaches a telecommunication system with subscriber controlled

features modification. See the title. Majmudar provides a system which allows a user

using a product/service to select features to be added to the user's current subscription.

See the abstract. Once the desired features are selected, a remote central office

transmits an appropriate software package containing selected features to the user.

It would have been obvious to one of ordinary skill in the art at the time of the invention

to incorporate the teachings of Majmudar into the system of Abelow in order to allow a

user to also select additional features or the availability of an identified software

component wherein the identified component is not within the subset of software

components. The motivation would have been to instantly allow users to make changes

in their current usage of a product/service thereby permitting great flexibility of a

product/service for better customer service and loyalty.

Collecting demographic and geographic data and threshold data are taught in the

combination of Abelow and Majmudar.

As per claim 8, a user in the system of Majmudar interactively communicates by

a visual communication and tactile response mechanism.

Claim 26 recites limitations contained in claim 1 and these limitations are likewise

rejected. Claim 26 further includes features that the usage data pattern in an indicative

of frequency of usage. As per this feature, the Examiner asserts that market analysis

data usually includes usage data pattern indicative of frequency of usage or purchase of

a product/service. It is noted that Abelow tracks usage data of a particular

product/service. The usage data being an indicative of frequency of usage would have

been obvious to one of ordinary skill in the art to do in the combination of Abelow and

Majmudar in order to provide associated vendors with data that can be useful in a

market analysis system so as to improve the product and/or provide better customer

service.

(10) Response to Argument

Appellant's representative states that "Abelow (US 5,999,908) is concerned with

collecting data indicative of the user's preferences to design products on dependence on user

feedback, Abelow, Col. 71, lines 5- 7, (some of which is explicitly requested and entered, some

of which is implicitly collected, via "probes), thereby providing a means of enabling the products

to evolve in a customer-focused manner. Id. at Col. 71, lines 19 - 22."

In response, Appellant admits that Abelow teaches collecting usage data describing user

interaction with a subset of software components since Abelow collects usage data by means of a

module being attached to a product or service being used by the user. The module also stores the

collected data to be analyzed.

Abelow teach the claimed functions of "providing a computer system with a subset of

software components from said set of software components; collecting usage data describing

user interaction with the subset of software components" and "analyzing said usage data so as to

identify a usage data pattern". See also columns 71-72.

Appellant then states that "Since Abelow is concerned with providing a system in respect

of which products can evolve, any upgrades that are offered to the user are different to the

software modules that the user was issued with in the first instance (and in relation to which the

data collected is performed)" and "Thus does not disclose "provision of software components

from a set of software components, wherein composition of the set is predefined".

In response, Abelow states that "The module being attached to a product or service

includes means for storing and collecting a customer's usage of the product and transmits

collected data to a remote vendor using a transmission medium. The module also includes entry

means and voice and speaker means for interacting with the consumer" (see column 10, line 50

to column 11, line 8). On column 10, lines 10-15, it is stated "Built-in electronic mail lets them

receive additional on-line services from those professionals 772, 726, 734 (such as validation of

a product's set of dialogs) or buy additional services and data from them". Thus, the module

analyzes user's interaction with a product during a customer's usage of the product. See column

9, lines 38-40 where it is stated "The CB-PD Module 670 obtains its findings while customers

are in the middle of product uses 668, during their real situations and needs" and column 17, line

52 to column 18, line 37 and column 19, line 28 to column 20, line 27 where Abelow teaches a

vendor may deliver dynamic product improvements through on-line communications built into

the product, to upgrade existing products in the field while they are in the hands of customers".

In so far as noted, Abelow teaches providing software functionality as an instant upgrade

to an existing product and also as an upgrade of a future development of the software product.

Appellant then argues that the Office action suggests that Abelow teaches providing users

with additional products and services by citing column 13, lines 55-58. Appellant then argues

that this passage deals with only point of use transactions where the customer directly requests

additional products and that although Abelow describes the collecting of data indicative of the

user/customer's preferences Abelow uses the collected data to design products in dependence on

user feedback which is how the system enables the products to evolve in a customer-focused

manner.

In response, Abelow does provide this teaching. Additionally Abelow teaches delivering

" dynamic product improvements through on-line communications built into the product, to

upgrade existing products in the field while they are in the hands of customers". See column 20,

lines 19-23 of Abelow. The software or products that users of the Abelow system are using

include a subset of software functionality from a set of available functions since users are using

the software or product into which the module is installed and the system of Abelow provides

users with additional features being delivered to them immediately upon request (column 20,

lines 6-9), and the system provides users the opportunity to purchase on-line additional services

and data (column 10, lines 10-15 of Abelow). Abelow also teaches the claimed "collecting data

describing user interaction with the subset of software product functionality" by collecting usage

data of a product or software (see column 19, line 20 to column 20, line30 of Abelow).

Appellant then argues that Abelow does not disclose collecting and analyzing usage data

that describes user interaction with a subset of (a predefined set of)software components to

identify a usage data pattern.

The Examiner disagrees with the appellant's assertion because when the user is using a

particular software, the user is only using dedicated segments of the software product related to

the task that that particular segment is designed to perform. In addition, Abelow states "As the

Customer uses the product 16, pre-programmed trigger points are checked in the CB-PD Module

or by the Customer. If a trigger point has not been reached, the customer's use is not interrupted.

If a trigger point is reached, the CB-PD Module requests the customer's participation in a

Development interaction". See column 17, line 55 to column 18, line 10. Thus, Abelow clearly

teaches collecting and analyzing usage data that describes user interaction with a subset of a

predefined set of software components to identify a usage data pattern.

It is noted that Abelow teaches providing software functionality as an instant to an

existing product and also as an upgrade of a future development of the software product. Both

the instant functions and the future functionalities are interpreted as a second, different software

component, wherein both components being with a predefined set of software components. The

alerting and selection of the different component is not explicitly indicated in Abelow.

Majmudar discloses a telecommunication system and method "for allowing a subscriber to select telephone features from the subscriber terminal". "The subscriber terminal includes a touch screen display and a customer premises computer. The terminal, in response to a touching of the appropriate area of the screen, displays a list of all possible telephone features available to this subscriber terminal together with an indication of currently subscribed features. By touching the screen in the appropriate areas, the subscriber may select features to be added or deleted. The information regarding the subscriber selection is transmitted to the central office to which the terminal is connected. The central office maintains a set of software packages corresponding to each of the possible combinations of features to be selected by a subscriber and in response to information from the terminal defining a new set of features, the central office transmits the appropriate software package to the terminal. From then on, the terminal is reconfigured to provide the newly selected set of features".   See the abstract of Majmudar.

Appellant then argues that Majmudar does not cure the deficiencies of Abelow by failing to disclose:

"collecting usage data describing user interaction with the subset of software components"

"analyzing said usage data so as to identify a usage data pattern"

"analyzing said usage data so as to identify a usage data pattern indicative of frequency of usage"

"identifying a software component from the set based on said identified usage data pattern and predetermined rules specifying a relationship between usage of a first software

component and selection of a second, different, software component, both said components

being within said predefined set of software components".

In response, Majmudar had not been applied to denote teachings of the collecting and

analyzing functions. These were noted to be taught or rendered obvious over Abelow. The

identifying of a different software component based on usage data and predetermined rules were

also noted to be taught or rendered obvious over Abelow as noted above. Majmudar has been

used to denote teachings of a consumer using a product and selecting different additional features

of that product. See the abstract of Majmudar.

Appellant's argument that Majmudar does not alerting to an availability of said identified

software component since instead of the alerting being performed in dependence of previously

performed monitoring and analyzing of usage data, the user has to pull information relating to

the available software components.

In response, appellant is referred to the above noted paragraphs where it has been

discussed that Abelow alerts users of available functions of a user's product which is being used

by the user. Abelow collects usage data information and alerts users of both instant

functionalities to be delivered online and further functionalities to be delivered at a future time.

The user selecting a second and different software functionality is taught by Majmudar.

It would have been obvious to one of ordinary skill in the art at the time of the invention

to incorporate the teachings of Majmudar into the system of Abelow in order to allow a user to

also select additional features or the availability of an identified software component wherein the

identified component is not within the subset of software components. The motivation would

have been to instantly allow users to make changes in their current usage of a product/service

thereby permitting great flexibility of a product/service for better customer service and loyalty.

Appellant then argues that the Examiner's motivation is not found in either Abelow or

Majmudar and that the Examiner is using hindsight to support the Examiner's rationale.

In response to applicant's argument that the examiner's conclusion of obviousness is

based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the

time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392,

170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references,

the examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Abelow teaches alerting a user of a product functions to instantly upgrade the

product in user or to upgrade the product in use in the further by detecting usage pattern.

Majmudar clearly teaches allowing a user to select new and available different functions as an

upgrade to a product or service being used by the user. See the abstract of Majmudar. It would

have been obvious to one of ordinary skill in the art at the time the invention was made to

combine the teachings of Abelow with Majmudar since Abelow indicates that their module can

be embedded in any particular product or service for detecting and analyzing usage data and is

capable of alerting users of an availability of a different instant or future function of the product.

Steps or functions of identifying for selection available different functions of a product being

used by a user of a product are taught by Majmudar. Thus, one of ordinary skill in the art at the

time the invention was made would have been motivated to combined Abelow with Majmudar in

order to allow a user to obtain instant different functionalities of a product as would be desired

thus, maintaining a loyal customer. Thus, the Examiner's analysis is not based on improper

hindsight or motivation, but is based on rationale that would have been made by one of ordinary

skilled in the art when viewing Abelow and Majmudar taken in combination.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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